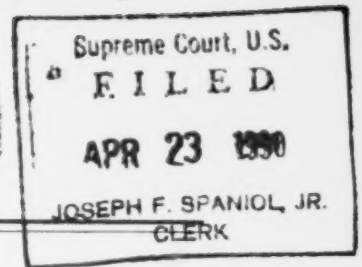


No. 89 - 1481



IN THE
Supreme Court of the United States
OCTOBER TERM, 1989

SHAT-R-SHIELD, INC.,

Petitioner,

v.

TROJAN, INC.,

Respondent.

On Petition For Writ Of Certiorari To The United
States Court Of Appeals For The Federal Circuit

**RESPONDENT'S BRIEF IN OPPOSITION
TO PETITION FOR WRIT OF CERTIORARI**

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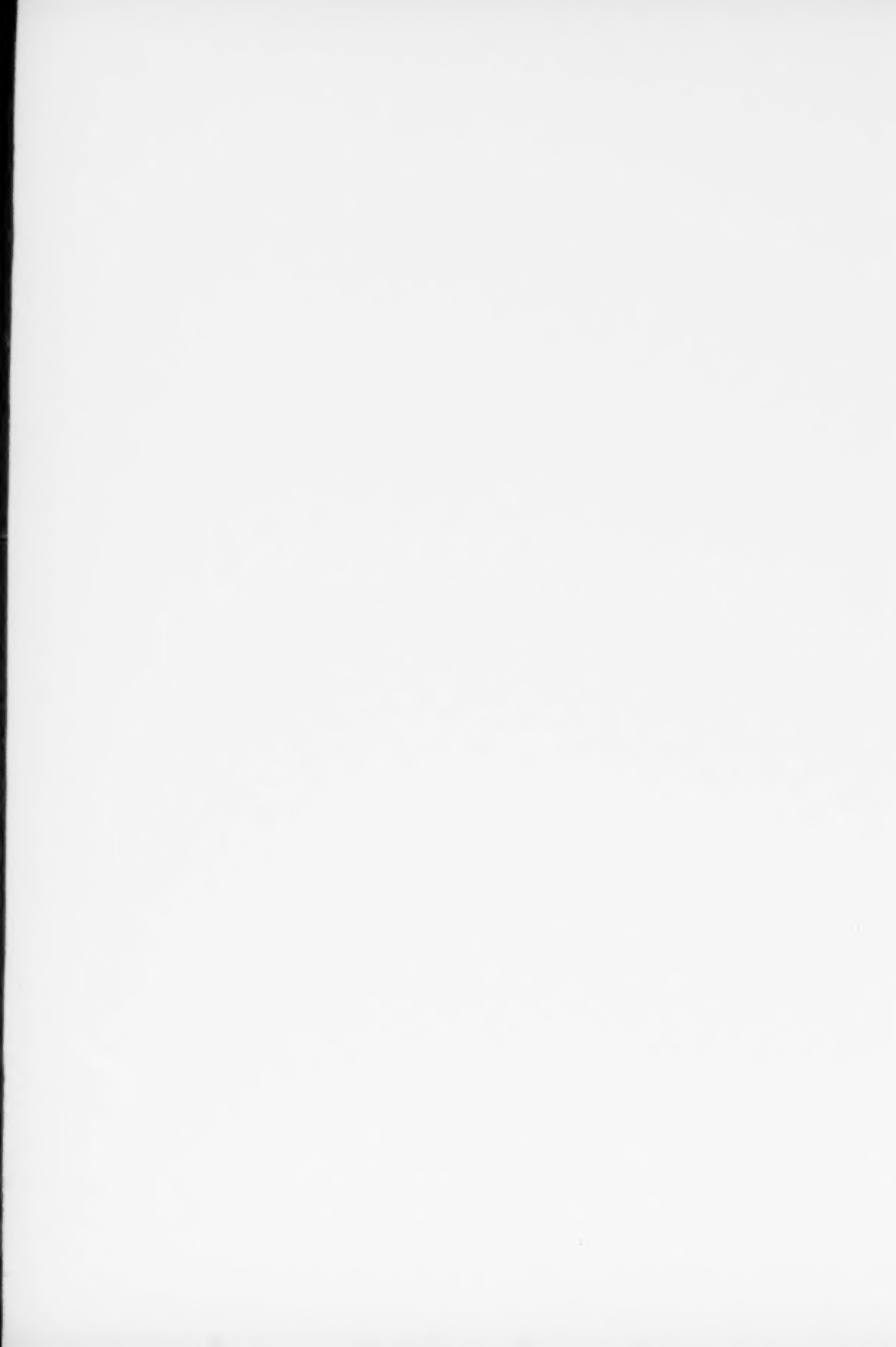


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Respondent Trojan, Inc. ("Trojan") hereby opposes the petition for a writ of certiorari for the reasons set forth below.

I.

THE PETITION FOR A WRIT TO REVIEW THE JUDGMENT IN APPEAL NO. 89-1027 WAS NOT TIMELY, AND EVEN IF IT WERE TIMELY, SHOULD BE DENIED ON THE MERITS

28 U.S.C. Section 2101(c) provides that a writ of certiorari shall be applied for within ninety days after the

entry of a judgment or decree. The decision of the Court of Appeals in Appeal No. 89-1027, one of the three appeals below, was rendered on September 12, 1989 (Pet. 5a*). No petition for rehearing was filed. This petition for a writ of certiorari was not filed until March 21, 1990, 190 days later, and much too late.

Thus, the third of the questions purportedly in issue here (Pet. i), relating to Section 133(a)(3) of the Federal Court Improvement Act (28 U.S.C. Section 1491(a)(3)) is not in fact properly before the Court.

Even if the question were properly before the Court, the judgment of the Court of Appeals that Section 1491(a)(3) is inapplicable to patent suits in the district courts was clearly correct. As pointed out in that judgment, Section 1491(a)(3) is limited by its terms to The United States Claims Court (Pet. 7a), and is further limited to contract claims as opposed to patent infringement litigation (Pet. 7a). Moreover, the Court of Appeals correctly held that 28 U.S.C. Section 1498(a) precludes injunctive relief against an alleged patent infringer's bidding on government contracts (Pet. 9a). As to either holding, there is no conflict between the circuits, and no conflict with any applicable decisions of this Court.

Thus, both because the petition was untimely and because there are no special and important reasons for review on writ of certiorari, the petition should be denied with respect to Appeal No. 89-1027.

* References are to the page numbers of the Petition.

II.

THERE ARE NO SPECIAL AND IMPORTANT REASONS FOR REVIEW OF THE JUDGMENT IN APPEALS NOS. 88-1528 AND -1529

The judgment of the Court of Appeals in Appeals Nos. 88-1528 and -1529 was based on an opinion which was not prepared for publication in a printed volume because it “does not add significantly to the body of law and is not of widespread legal interest” (Pet. 1a). That indeed is the case, and the petition accordingly should be denied.

A. The Court of Appeals Did Not Construe The Evans Patent “Broadly”

Petitioner takes the position that the point of law on which the Court of Appeals reversed the District Court was whether the Evans patent should have been construed “liberally or exactly” (Pet. 6-7). Petitioner is wrong.

The opinion of the Court of Appeals says nothing about how the Evans patent should be construed. It does not say that it should be construed either liberally or broadly. It simply states that “The relevance of a patent as prior art is not affected by whether the claimed invention was ever commercialized” (Pet. 3a), citing two decisions of its predecessor court, the Court of Customs and Patent Appeals. Thus, the Court of Appeals held that the district court erred in discounting the Evans patent because of lack of commercialization. In other words, the Evans patent speaks for itself, like any other prior art patent. Indeed, if commercialization were a prerequisite for a patent to qualify as prior art, only a minor proportion of issued patents would qualify because most patents are not commercialized.

Thus, the Court of Appeals did not establish a rule of construction with respect to uncommercialized patents; it simply held that a patent may not be discounted for lack of commercialization.

B. The Holding Of The Court Of Appeals As To The Evans Patent Is Not In Conflict With Any Applicable Decision Of This Court

Even though the Court of Appeals did not apply a rule of "liberal construction" to the Evans patent, petitioner argues that such a rule would be in conflict with decisions of this Court. The principal decision on which petitioner relies is *Barbed Wire Patent*, 143 U.S. 275 (1892), decided nearly a hundred years ago. It is totally irrelevant.

Barbed Wire Patent dealt with the validity of a patent in light of two different types of prior art; prior patents and prior uses:

"To determine satisfactorily the question whether there is involved in this device sufficient of novelty to support a patent, it is necessary to consider somewhat at length the progress which had been made in constructing barbed wire fences prior to the issue of this patent, as it appears both from the face of the prior patents themselves and from the oral evidence introduced by the defendants tending to show an unpatented use of such device before the application was made in this case." (143 U.S. 277)

The court proceeded to analyze the prior patents, of which two had not been commercialized and one had been commercialized to a considerable extent. It noted that the inventor of the patent in suit had taken "... the final step which had turned a failure into a success. In the law of patents it is the last step that wins." (143 U.S. 283).

At no point in its analysis did the court make any distinction as to how the prior patents should be construed in light of their extent of commercialization. Indeed, in the above quotation the court seems to have taken all of them at face value, just as the Court of Appeals took the Evans patent at face value here. It was only in connection with the prior *unpatented* uses that the court was hesitant:

“Thus far we have considered, as bearing upon the state of the art, devices, the character, construction and scope of which were exactly defined in the specifications and drawings of actual patents, the only question presented being the proper interpretation of such patents, and the bounds they had set to the ingenuity of succeeding inventors. We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony.”
(143 U.S. 284)

Nothing in *Barbed Wire* supports petitioner's contention that this court has dictated how an uncommercialized patent is to be construed. Of a certainty, there is no holding in *Barbed Wire* that an uncommercialized patent must be construed “exactly”, as petitioner argues. Read fairly, *Barbed Wire* is fully consistent with how the Court of Appeals treated the Evans patent; it says what it says.

The other Supreme Court cases cited by petitioner are even less relevant. There has never been a pronouncement by this court that uncommercialized patents should be treated any differently as prior art than patents which have been commercialized.

C. The Holding Of The Court Of Appeals As To The Evans Patent Is Not In Conflict With Other Courts of Appeals And, Even If It Were, The Court Of Appeals Was Established To Resolve Such Conflicts

Petitioner, clinging to its fallacious premise that the Court of Appeals adopted a rule of "liberal construction" of the Evans patent, argues that such a rule would be in conflict with hoary decisions of the Second, Ninth, and District of Columbia Circuits (Pet. 8).

All of the decisions on which petitioner relies are clearly distinguishable. The *Cimiotti* case, 115 F. 98 (2nd Cir. 1902), says nothing about reading a prior art patent narrowly or broadly. The *Permutit* case, 279 F. 713 (2nd Cir. 1922), involved a *foreign* prior art patent, not a U.S. patent, and foreign patents indeed are strictly construed. The *Lockwood* case, 324 F.2d 82 (9th Cir. 1963), dealt with whether the claims of an uncommercialized patent should be narrowly or broadly construed for purposes of determining infringement of the patent there in suit; it had nothing to do with construing a prior art patent for purposes of determining validity of the patent. The *Coykendall* case, 29 F.2d 868 (D.C. Cir. 1928) says nothing about reading a prior art patent narrowly or broadly.

Thus, petitioner has failed to show that there was a conflict in the circuits.

Even if there had been a conflict among the circuits before the establishment of the Court of Appeals for the Federal Circuit, it would be of no consequence here because one of the reasons for that court's establishment was to eliminate such conflicts in patent cases:

"Colt correctly observes that one of Congress' objectives in creating a Federal Circuit with exclusive jurisdiction over certain patent cases was 'to reduce the widespread lack of uniformity and uncertainty of

legal doctrine that exist[ed] in the administration of patent law.' H. R. Rep. No. 97-312, p. 23 (1981). . . ." (*Christianson v. Colt Industries*, 108 S.Ct. 2166, 2176 (1981))

Thus, if the law previously was unclear it was made clear as follows in the decision below:

"The relevance of a patent as prior art is not affected by whether the claimed invention was ever commercialized" (Pet. 3a).

D. There Is No Authority For Requiring Testimonial Evidence In Addition To Documentary Evidence In Determining Obviousness Under 35 U.S.C. Section 103, And The Judgment Below Is Fully In Accord With *Graham v. Deere*

Petitioner takes the novel position that testimonial evidence is necessary to a court's determination of obviousness under 35 U.S.C. Section 103 (Pet. 9). Petitioner cites no authority for this proposition, nor is there such authority. On the contrary, the documentary evidence provided by patents was recognized in *Barbed Wire* as far superior to testimonial evidence:

"We have now to deal with certain unpatented devices, claimed to be complete anticipations of this patent, the existence and use of which are proven only by oral testimony. In view of the unsatisfactory character of such testimony, arising from the forgetfulness of witnesses, their liability to mistakes, their proneness to recollect things as the party calling them would have them recollect them, aside from the temptation to actual perjury, courts have not only imposed upon defendants the burden of proving such devices, but have required that the proof shall be clear, satisfactory and beyond a reasonable doubt." (143 U.S. 284)

Petitioner further appears to contend that the absence of testimonial evidence transforms the court into a pat-

ent examiner in deciding the issue of obviousness under 35 U.S.C. Section 103. No explanation is given as to why the presence of testimonial evidence would change the situation.

In any event, *Graham v. John Deere Co.*, 383 U.S. 1 (1966) makes it clear that the duties of the Patent and Trademark Office and the courts are indeed the same:

“While we have focused attention on the appropriate standard to be applied by the courts, it must be remembered that the primary responsibility for sifting out unpatentable material lies in the Patent Office. To await litigation is—for all practical purposes—to debilitate the patent system. We have observed a notorious difference between the standards applied by the Patent Office and by the courts. While many reasons can be adduced to explain the discrepancy, one may well be the free rein often exercised by Examiners in their use of the concept of ‘invention.’

* * *

Although we conclude here that the inquiry which the Patent Office and the courts must make as to patentability must be beamed with greater intensity on the requirements of Section 103, it bears repeating that we find no change in the general strictness with which the overall test is to be applied. We have been urged to find in Section 103 a relaxed standard, supposedly a congressional reaction to the ‘increased standard’ applied by this Court in its decision over the last 20 or 30 years. The standard has remained invariable in this Court.” (383 U.S. 18, 19)

To contend, as petitioner does, that the courts are incapable of determining whether or not the claims of a patent are obvious under 35 U.S.C. Section 103 in the absence of testimonial evidence flies in the face of *Graham v. Deere*. There, this Court itself analyzed the scope and content of the prior art, determined the differences between

the prior art and the patent claims in issue, ascertained the level of ordinary skill in the art and, against that background, determined that the claimed subject matter of the patent in suit was obvious (383 U.S. 19-26). There is nothing in the opinion which suggests that, in so doing, the court needed testimonial evidence or even considered testimonial evidence.

III.

CONCLUSION

In Appeal No. 89-1027, the petition for writ of certiorari should be denied because it was not timely. In that appeal and in Appeals Nos. 88-1528 and -1529, the petition for writ of certiorari should be denied because there are no special and important reasons for review.

Respectfully submitted,

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